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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/390,846 09/14/99 KOK

J I/95150-US/D

HM12/1121

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EXAMINER

FIELDS, I

ART UNIT

PAPER NUMBER

1645

5

DATE MAILED:

11/21/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/390,846

Applicant(s)

KOK ET AL.

Examiner

Ilesha P Fields

Art Unit

1645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4-42 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claims ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some * c) ☐ None of the CERTIFIED copies of the priority documents have been:
1. ☐ received.
2. ☐ received in Application No. (Series Code / Serial Number) ____.
3. ☐ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of Group I, claims 1-3, (Paper Number 9) received on 1
November 2, 2000 is acknowledged. The traversal is on the grounds that according to 2
MPEP 803, if the search and examination of an entire application can be made without 3
serious burden, the Examiner must examine it on the merits, even though it includes 4
claims to distinct or independent inventions. The argument that the restriction is 5
improper because the application can be searched without serious burden is not found 6
persuasive. It is the Examiner's position that it would be an undue burden to search all 7
Groups as indicated by the divergent subject matter and different classification. For 8
instance a search of the prior art to Group I would not reveal prior art of Groups II-X as 9
indicated by their different classification. Further with regards to the traversal on the 10
ground that it would not be a serious burden to search Groups I and III it is the 11
Examiner's position that the search for each of the above inventions is not co-extensive 12
particularly with regard to the literature search. A reference which would anticipate the 13
invention of one group would not necessarily anticipate or make obvious any of the 14
other groups. Consequently, claims 1-42 are pending in the instant application, and 15
claims 4-42 are withdrawn from further consideration.

The requirement is still deemed proper and is therefore made FINAL.

SEQUENCE LISTING

1. The instant application currently is not in compliance with the sequence requirements.

The following paragraph, or language having the same effect, can be used to invoke the procedures of 37 CFR section 1.821(e) in which an identical computer readable form from another application is used in a given application. The paragraph should be incorporated into a separate paper to be submitted in the given application:

The computer readable form in this application, 09/390846, is identical with that filed in Application Number 08/ 676882, filed July 3, 1996. In accordance with 37 CFR 1.821(e), please use the [first filed, last-filed or only, whichever is applicable] computer readable form filed in that application as the computer readable form for the instant application. It is understood that the Patent and Trademark Office will make the necessary change in application number and filing date for the computer readable form that will be used for the instant application. A paper copy of the Sequence Listing is [included in the originally-filed specification of the instant application, included in a separately filed preliminary amendment for incorporation into the specification, whichever is applicable]. For examination purposes the CRF of 08/676882 has been used.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claim is vague and indefinite in the recitation of “biologically functional equivalent”. One of skill in the art would be unable to determine the metes and bounds of such a limitation. For instance what constitutes a functional equivalent? Without a clear definition as to what constitutes a biologically functional equivalent, one of skill in the art would be unable to replicate the claims.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-3, are rejected under 35 U.S.C. 102(b) as being anticipated by Wisher.

The claims are drawn to a protein having antigenic determinants of *Eimeria* lactate dehydrogenase.

Wisher *et al.* (*Molecular and Biochemical Parasitology*, 2 (1986) pp. 7-15 disclose a *Eimeria* protein. The specification (page 6, lines 14-15) sets forth that the claimed protein has a monomeric molecular weight of about 37 kD.

Wisher *et al.* disclose a *Eimeria* protein with a monomeric molecular weight of about 37 kD. In view that Wisher *et al.* set forth a 37 kD *Eimeria* protein, it is deemed to be a biologically functional equivalent of the instant claimed 37 kD *Eimeria* protein.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Iesha P Fields whose telephone number is (703) 605-1208. The examiner can normally be reached on 7am-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynette Smith can be reached on (703) 308-3909. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3014 for regular communications and (703) 308-4242 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Ilesha Fields

November 20, 2000

Mark G. ...
ALBERT NABUCCO
primary PATENT EXAMINER